REMARKS

With this Amendment, Applicants cancel Claim 1, and amend Claim 2 in order to place it into independent form. Therefore Claims 2-9 are all the claims currently pending in the application.

Claims

Claims 2, 5, 6, and 8 stand rejected under 35 U.S.C. § 102(e) as allegedly anticipated by Okazawa, U.S. Patent No. 5,937,148 ("Okazawa"). Claims 3, 4, 7, and 9 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Okazawa in view of JP 64-20185 ("'185"). Applicants respectfully traverse these rejections as follows.

Applicants respectfully submit that Okazawa fails, both alone and in combination with '185, to teach or suggest all of the limitations of the present invention as recited in Claims 2 and 7-9. Neither Okazawa, nor '185 teach or suggest storing a recovery program in an image memory, as required by each of Claims 2 and 7-9.

As the Examiner acknowledges (Office Action, para. 47), Okazawa fails to expressly disclose storing the recovery program in image memory. The Examiner appears to argue that this element is inherent in the system of Okazawa. The Examiner argues that because the RAM is the only memory available during the sleep mode, that the recovery program must be stored in the RAM, which can be image memory, since image memory is RAM.

However, contrary to the assertion of the Examiner, it is not inherent, nor would it be obvious from the disclosure of either Okazawa or '185 to store the recovery program in image memory, as required by Claims 2 and 7-9. According to the disclosure of Okazawa, describing

Figure 1, "an image memory for, developing a bit map image," among other elements which are not shown are also provided on the bus 118. (Okazawa, col. 4, lns. 26-29). Figure 1 clearly illustrates a RAM 116 connected to the bus. Clearly, as the image memory is "not shown" (col. 4, lns. 12, and 26-29), it is not contained in the RAM 116, which is prominently illustrated. Therefore, even if a recovery program were to be stored in the RAM 116, which is not clearly disclosed in Okazawa, the RAM is not the image memory, and therefore, Okazawa fails to disclose or suggest storing a recovery program in image memory.

When a reference fails to expressly disclose each and every element of a claimed invention, as in this case, it can be argued that the reference "inherently" teaches the missing element of elements of the claimed invention. *See In re Oelrich*, 666 F.2d 578, 581 (Fed. Cir. 1981). However, evidence of inherency in a reference "must make it clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *Continental Can Co. USA Inc. v. Monsanto Co.*, 948 F.2d 1264, 1269 (Fed. Cir. 1991). "Inherency however, may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient." *Id.* (citing *In re Oelrich,* at 581, *quoting Hansgirg v. Kemmer,* 102 F.2d 212, 214 (C.C.P.A. 1939))(*emphasis in original*). Therefore, it is not enough that the Examiner not the possibility that the RAM in which a recovery program is stored *could* be used as image memory. Rather, he must show that it is the *only* possibility, which he has not done.

Therefore, for at least the above reasons, Applicants respectfully submit that Claims 2 and 8 are not anticipated by Okazawa and that Claims 7 and 9 are patentable over a reasonable

combination of Okazawa and '185, and request that the Examiner withdraw the rejections of these claims.

Further, Applicants respectfully submit that Claims 3, 4, 5, and 6 are patentable at least by virtue of their dependence on Claim 2.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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